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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/670,511 | 09/26/2003 | Haruhiko Kinoshita | Q77715 | 8637 |

23373          7590          02/20/2008
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| EXAMINER |
|---|
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| ART UNIT | PAPER NUMBER |
|---|---|
| 2623 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 02/20/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/670,511 | KINOSHITA, HARUHIKO |
| | **Examiner** | **Art Unit** | |
| | ALAN LUONG | 4126 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on _26 September 2003_.

2a)☐ This action is **FINAL**.  2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) _1-18_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-18_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _26 September 2003_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):

    a)☐ All  b)☐ Some * c)☐ None of:

        1.☒ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _See Continuation Sheet_.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) Paper No(s)/Mail Date :Feb 16, 2007, 12/13/2005, 01/06/2004.

## DETAILED ACTION

1.      This is the initial Office Action based on the 10/670511 application filed on Sept

26, 2003. Claims 1-18, as originally filed, are currently pending and have been

considered below.

### Claim Objections

2.      Claim 8 is objected to because of the following informalities:

At line 9 of claim recites "urther", which appear to be a misspelling of the word "further".

Appropriate correction is required.

3.      Claim 9 is objected to under 37 CFR 1.75 as being a substantial duplicate of

claim 6.  When two claims in an application are duplicates or else are so close in

content that they both cover the same thing, despite a slight difference in wording, it is

proper after allowing one claim to object to the other as being a substantial duplicate of

the allowed claim.  See MPEP § 706.03(k).

### Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4.      Claims 16, 17 and 18 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter as follows. Claims 16, 17, 18 define

a support program controls a computer to execute. However, the claim does not define

a computer readable medium or memory and is thus non-statutory for that reason (i.e.,

"When functional descriptive material is recorded on some computer-readable medium

it becomes structurally and functionally interrelated to the medium and will be statutory

in most cases since use of technology permits the function of the descriptive material to

be realized" - Guidelines Annex

## Claim Rejections - 35 USC § 103

5.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.      Claims 1, 7, 10, 14, 16 and 18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over US Pub. No. 2001/0052001 A1 published by Stern; in view of US

Pub. No. 2002/0069107 A1 published by Werner.

**Regarding to claims 1**:  Stern discloses a support server (a multimedia server

160 in commercial sales outlet 130 of FIG. 1) that supports determination of a providing

route of a content, provided via a communication network (125 of FIG. 1A, B, ¶0145),

from a content providing terminal (an advertiser 102, a recording company 104, a movie

studio 106 or another content provider, such as other content provider 108,US'001, FIG.

1A, ¶0023, ¶0024, ¶0025)  that provides a content (Digital data files 122 of FIG. 1A;

content includes content presented in MPEG1 and MPEG2 video and audio stream

format, although the present system should not be limited to using only those formats.

See ¶0021 lines 7-10), to a content user terminal (a commercial sales outlet 130 of

FIG. 1A, 1B), placed in matched-condition information to the retrieval device comprising:

a receiving unit (135 of FIG. 1B) that receives a retrieval information provided

by information provider (102, 104, 106, 108 of FIG. 1A) (see US'001, ¶0105) and a

retrieval information request provided by content user terminals (a commercial sales

outlet 130 of FIG. 1A, 1B), via the communication network (125 of FIG. 1A, B) (see

US'001, ¶0104, ¶0105, ¶0106, ¶0144).

a storing unit (multimedia server 160 in commercial sales outlet 130 of FIG. 1)

that stores the retrieval information, received by said 135 of FIG. 1B (US'001, ¶0179);

and

a providing destination selecting unit (a multimedia server 160 in commercial

sales outlet 130 of FIG. 1B) that extracts the matched-condition information from the

information provider stored in said storing unit, US'001, ¶0145) and selects a content

user terminal, (one of listening posts 185, at one or more of listening posts 185, at one

or more of audio/video endcaps 190, on multimedia server 160, Wall-of-eyes 180 of

FIG. 1B; see US'001, ¶0180).

However, Stern fails to disclose facility condition information, showing a condition

of a facility where the content is to be used, the facility condition information and the

facility information wherein a user terminal placed at a facility specified by the extracted

facility information, as the providing destination of the content.

In the same field of the server for supporting facility information distribution,

Werner discloses a system with a server (60 of FIG. 1) for storing facility condition

information, showing a condition of a facility (32a-32m of Fig.1) where the content is to

be used, the facility condition information and the facility information wherein a user

terminal placed at a facility specified by the extracted facility information(system 10 may

receive facility data that indicates a mechanical or electrical problem with a certain

theater and/or that indicates a particular data presentation unit is undergoing

maintenance or needs maintenance service; see US'107, ¶0047 lines 1-6) as the

providing  destination of the content. (See US'107, ¶0026 to ¶0030). Therefore, it would

have been obvious to one of ordinary skill in the art at the time of applicant's invention

was made to modify the facility condition information, showing a condition of a facility

where the content is to be used as taught by Werner in the support server invention of

Stern, in order to control and select suitable location of facility which matched condition

information from a content provider.

**Regarding to claim 7:** Stern discloses a support server (a multimedia server

160 in commercial sales outlet 130 of FIG. 1) that supports determination of a providing

route of a content, provided via a communication network (125 of FIG. 1A, B), from a

content providing terminal (an advertiser 102, a recording company 104, a movie studio

106 or another content provider, such as other content provider 108,US'001, FIG. 1A,

¶0023, ¶0024, ¶0025)  that provides a content (Digital data files 122 of FIG. 1A; content

includes content presented in MPEG1 and MPEG2 video and audio stream format, although the present system should not be limited to using only those formats. See ¶0021 lines 7-10), to a content user terminal placed in a facility where the content is to be used (a commercial sales outlet 130 of FIG. 1A, 1B), comprising:

a receiving unit (135 of FIG. 1B) that receives the content information provided by content providing terminals (see blocks 102, 104, 106, 108 of FIG. 1A) and content condition information showing a condition of a content that is to be used in the facility, via the communication network (125 of FIG. 1A, B) (see US'001, ¶0104, ¶0105, ¶0106, ¶0144, ¶0028, ¶0218 to ¶0042, ¶0044 to ¶0047, ¶0055 and Table 1).

a storing unit (Interactive Endcaps 190, multimedia server 160 in commercial sales outlet 130 of FIG. 1B) that stores the content information (Digital data files 122 of FIG. 1A), received by said receiver (135 of FIG. 1B) (US'001, ¶0145, ¶0179);

However, Stern explicitly fails to disclose a providing content selecting unit that extracts content information that meets the condition shown by the content condition information, from the content information stored in said storing unit, and selects a content specified by the extracted content information, as the content to provide to said content user terminal.

Werner, the same endeavor, teaches a providing content selecting unit that extracts content information that meets the condition shown by the content condition information as the content to provide to said content user terminal (a graphic user interface (GUI), pull-down menus, and/or hyperlinked entries or forms. In such embodiments, the user

may select, enter, modify or print data, none, some or all of which may be in response

to prompting by system 10;see US'107, FIGs. 1, 3, ¶0041-¶0044) from the content

information stored in said storing unit (40 of FIG. 1, ¶0024, ¶0025), and selects a

content specified by the extracted content information (¶0045) . Therefore, it would

have been obvious to one of ordinary skill in the art at the time of applicant's invention

was made to modify the providing content selecting unit that extracts content

information that meets the condition shown by the content condition information as the

content to provide to said content user terminal as taught by Werner in Stern 's Network

Operation Center, in order to scheduling and controlling the content user terminal

placed in a facility where the content is to be used.

**Regarding to claim 10**: The scope of claim 10 is substantially the same or

slightly broader than that of the claim 1 since it requires every structural element of

claim 1. Thus, claim 10 is also taught by Stern and in view of Werner for the same

reasons provided in the rejection of claim 1.

**Regarding to claim 14:** As discussed above since the support server disclosed

by Stern, in view of Werner teach every structural element and its function required by

the server in claim 7 and since this method claim 14 merely repeats the functions of

claim 7, claim 14 must also be taught by Stern, in view of Werner (please see rejection

discussion in claim 7).

**Regarding to claim 16**: As discussed above since the support server disclosed

by Stern, in view of Werner teach every structural element and its function required by

the server in claim 1 and since the support program of claim 16 merely repeats the functions of claim 1, claim 16 must also be taught by Stern, in view of Werner (please see rejection discussion in claim 1).

**Regarding to claim 18**: As discussed above since the support server disclosed by Stern, in view of Werner teach every structural element and its function required by the server in claim 7 and since the support program of claim 18 merely repeats the functions of claim 7, claim 18 must also be taught by Stern, in view of Werner (please see rejection discussion in claim 7).

7.      Claims 2, 3, 8, 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern, in view of Werner and US Pub. No. 2003/0013436 A1 published by Son.

**Regarding to claim 2**: Stern and Werner disclose the support server 160 according to claim 1, Stern also discloses wherein

said receiving unit (128 and 135 of FIG. 1A) receives advertising information provided by said content providing terminal 102 of FIG. 1A) (US'001, ¶0023)

said storing unit (160 of FIG. 1A) stores the advertising information, which said receiving unit received (128 and 135 of FIG. 1A); see ¶0144, ¶0145; and

said support server further comprises an advertising selecting unit (Network Management Center 110 of FIG. 1A), which extracts advertising information that meets the condition shown by the advertising condition information (Repetition is kept to a minimum, while still meeting advertising objectives of advertisers. See ¶0218).

However, Stern as modified fails to teach an advertising agent condition

information request advertisement of the content and advertising agent information, and

an advertising agent selecting unit.

Son, in the same server supporting method, teaches the advertisement method

wherein receiving unit (21 of FIG. 2) receives advertising agent condition information

provided by said content providing terminal (from support server (41-44 of FIG. 2); see

US'436 ¶0031 lines 1-4), showing a condition of an advertising agent (the advertisers

80 who want to advertise, 80 of FIG. 1, US'436, ¶0037 lines 3-4) to request

advertisement of the content and advertising agent information, provided by advertising

agent terminals managed by advertising agents that advertise contents, showing

advertisement ability of the advertising agents (the user 60 requests an advertisement

from a wireless advertisement service provider through a network. The service including

messages, client managements, or advertisements is supplied to the user by way of a

wireless communication terminal or a web (i.e., internet) through a computer terminal,

see ¶0035 lines 1-5) (See Fig. 3, ¶0034 to ¶0038); storing unit (26 of FIG. 2) stores the

advertising agent condition information and the advertising agent information , which

said receiving unit received (storage unit 26 for storing the information passing through

the demodulator 24 which demodulates data signals of the advertising information

supplied from the receiver 21, ¶0032 lines 4-7)  and an advertising agent selecting unit

(20 of FIG. 2), which extracts advertising agent information that meets the condition

shown by the advertising agent condition information, from the advertising agent

information stored in the storing unit 26, and selects an advertising agent specified by

the extracted advertising agent information, as the advertising agent to request

advertisement of the content. (The auto-transferring step is composed of receiving

information about the advertisement and conditions of a place where the output unit is

installed, extracting information corresponding to an requirement of the user 60, sending

the selected information to the output unit 20. See ¶0036 lines 9-14). Therefore, it would

have been obvious to one of ordinary skill in the art at the time of applicant's invention

was made to modify the Stern and Werner 's support server  with the advertising agent

condition information and the advertising agent information as taught by Son, in order to

control and select feature and promotional data for suitable facility location

**Regarding to claim 3**: The support server according to claim 2, Werner also

discloses wherein said content is film data used for running a film. (feature data 44

and/or promotional data 42 may be film that may be presented using standard

projectors. See US'107, ¶0007), (promotional data 42 may include promotional

materials such as advertisements or movie trailers that may be presented with a feature

film, see ¶0021) (features 44 may include video or television data, and/or feature films

or motion pictures, that are typically distributed by studios for presentation by service

providers such as movie theaters, multiplex owners, and the like. See US'107, ¶0022).

**Regarding to claim 8**: As discussed above since the support server disclosed

by Stern, Werner and Son teach every structural element and its function required by

the server claim 2 and since this method claim 8 merely repeats the functions of claim

2, claim 8 must also be teached by Stern, Werner  and Son (please see rejection

discussion in claim 2).

**Regarding to claim 11:** With respect to the method claim 10, as discussed above since the support server disclosed by Stern, Werner and Son teach every structural element and its function required by the server claim 2 and since this method claim 11 merely repeats the functions of claim 2, claim 11 must also be taught by Stern, Werner and Son (please see rejection discussion in claim 2).

**Regarding to claim 15:** With respect to the method claim 14, as discussed above since the support server disclosed by Stern, Werner and Son teach every structural element and its function required by the server claim 2 and since this method claim 15 merely repeats the functions of claim 2, claim 15 must also be taught by Stern, Werner and Son (please see rejection discussion in claim 2).

8.      Claims 4, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern, in view of Son.

**Regarding to claim 4:** Stern discloses a support server (a multimedia server 160 in commercial sales outlet 130 of FIG. 1) that supports determination of a providing route of a content, provided via a communication network (125 of FIG. 1A, B), from a content providing terminal (an advertiser 102, a recording company 104, a movie studio 106 or another content provider, such as other content provider 108,US'001, FIG. 1A, ¶0023, ¶0024, ¶0025) that provides a content (Digital data files 122 of FIG. 1A; content includes content presented in MPEG1 and MPEG2 video and audio stream format, although the present system should not be limited to using only those formats. See

¶0021 lines 7-10), to a content user terminal (a commercial sales outlet 130 of FIG. 1A, 1B), comprising:

a receiving unit (135 of FIG. 1B) that receives content information (Digital data files 122 of FIG. 1A; content includes content presented in MPEG1 and MPEG2 video and audio stream format, although the present system should not be limited to using only those formats. See ¶0021 lines 7-10) provided by content providing terminals (see blocks 102, 104, 106, 108 of FIG. 1A) and content condition information showing a condition of a content that is to be an advertising target (Advertising content from advertiser 102 consists of audiovisual content including commercials, "info-mercials", product demonstrations, and the like, See ¶0023) provided by an advertising agent terminal (102 of FIG.1A ) via the communication network (125 of FIG. 1A, B) (see US'001, ¶0104, ¶0105, ¶0106, ¶0144, ¶0217, ¶0218, ¶0231, ¶0244, ¶0311, ¶0315, ¶0327).

a storing unit (Interactive Endcaps 190, multimedia server 160 in commercial sales outlet 130 of FIG. 1B) that stores the content information (Digital data files 122 of FIG. 1A), received by said 135 of FIG. 1B (US'001, ¶0145, ¶0179);

However, Stern explicitly fails to disclose by an advertising agent that advertises a content and an advertisement target content selecting unit that extracts content information as the content to be advertised by the advertising agent.

Son, the same endeavor, discloses an advertising agent (80 of FIG. 1) that advertises a content (requesting an advertisement service to the advertising information

provider through a network by a user; transmitting the wireless advertising information

to the output unit from the advertising information provider in response to the service

requesting; see US' 436, ¶0009, ¶0011 lines 3-12, ¶0030 ) Therefore, it is possible to

establish appropriate information associated with conditions to which the user and

advertiser agree, and also to account the charges for advertising; see 0036 lines 14-17)

an advertisement target content selecting unit that extracts content information as the

content to be advertised by the advertising agent (The step S600 includes sub-steps of

introducing information about installment conditions and positions, and advertising

contents from the advertisers 80 who want to advertise, searching that there are an

advertise and an advertisement maker in agreement with the conditions etc. after

constructing a database from the introduced information; see FIG.3 step S600, ¶0037)

and an advertising agent selecting unit (selecting information corresponding to an user's

demand in the database; and transmitting the selected information to the output unit

through a wireless communication network and displaying the selected information on

the output unit. See claim 13 lines 4-8, and ¶0011). Therefore, it would have been

obvious to one of ordinary skill in the art at the time of applicant's invention was made to

modify the Stern s support server with an advertising agent terminal managed by an

advertising agent that advertises a content as taught by Son, in order to control and

select suitable feature and promotional data for desired facility location.

**Regarding to claim 12**: The scope of claim 12 is substantially the same or

slightly broader than that of the claim 4 since it requires every structural element of

claim 4. Thus, claim 12 is also taught by Stern and in view of Son for the same reasons

provided in the rejection of claim 4.

**Regarding to claim 17**: As discussed above since the support server

disclosed by Stern, in view of Son teach every structural element and its function

required by the server in claim 4 and since the support program of claim 17 merely

repeats the functions of claim 4, claim 17 must also be taught by Stern, in view of Son

(please see rejection discussion in claim 4).

9.     Claims 5, 6, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Stern, in view of Son and Werner.

**Regarding to claim 5**: Stern discloses the support server according to claim 4

including the receiving and the storing units above and Son teaches advertisement

target content selecting unit, but fails to teach receiving and storing facility information

that meets facility condition information provided by the advertising agent terminal.

In the same field of the server for supporting facility information distribution,

Werner discloses a system with a server (60 of FIG. 1) for storing facility condition

information, showing a condition of a facility (32a-32m of Fig.1) where the content is to

be used, the facility condition information and the facility information wherein a user

terminal placed at a facility specified by the extracted facility information(system 10 may

receive facility data that indicates a mechanical or electrical problem with a certain

theater and/or that indicates a particular data presentation unit is undergoing

maintenance or needs maintenance service; see US'107, ¶0047 lines 1-6) as the

providing destination of the content. (See US'107, ¶0026 to ¶0030). Therefore, it would

have been obvious to one of ordinary skill in the art at the time of applicant's invention

was made to modify the facility condition information, showing a condition of a facility

where the content is to be used as taught by Werner in the support server invention of

Stern and Son, in order to control and select suitable location of facility which matched

condition information from a content provider.

**Regarding to claims 6, 9**: Werner also discloses wherein said content is film

data used for running a film. (feature data 44 and/or promotional data 42 may be film

that may be presented using standard projectors. See US'107, ¶0007), (promotional

data 42 may include promotional materials such as advertisements or movie trailers that

may be presented with a feature film, see ¶0021) (features 44 may include video or

television data, and/or feature films or motion pictures, that are typically distributed by

studios for presentation by service providers such as movie theaters, multiplex owners,

and the like. See US'107, ¶0022).

**Regarding to claim 13**: As discussed above since the support server disclosed

by Stern, Werner and Son teach every structural element and its function required by

the server in claim 5 and since this method claim 13 merely repeats the functions of

claim 5, claim 13 must also be taught by Stern, Werner and Son (please see rejection

discussion in claim 5).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALAN LUONG whose telephone number is (571)270-5091. The examiner can normally be reached on Mon.-Thurs., 8:00am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Chow can be reached on (571) 272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ALAN LUONG/

Examiner, Art Unit 4126

/Lun-Yi Lao/

Primary Examiner, Art Unit 2629